

REMARKS

In the Office Action¹, the Examiner objected to the title of the invention; rejected claims 1, 2, 8-10, and 16 under 35 U.S.C. § 102(b) as being anticipated by Morie et al. (U.S. Patent No. 4,645,564, "Morie"); and indicated that claims 3-7 and 11-15 would be allowed if rewritten in independent form. Applicants thank the Examiner for the indication of allowable material, but respectfully traverse the rejection. Applicants have amended claims 1 and 9 and canceled claims 17-20, thus claims 1-16 remain under examination. In addition, Applicants confirm the election of claims 1-16.

By this amendment, the title has been amended in response to the Examiner's objection at page 3 of the Office Action. Accordingly, Applicants respectfully request that the Examiner withdraw his objection to the title.

In addition, Applicants have amended claims 1 and 9 to even more clearly define the present invention.

In order to support a rejection under 35 U.S.C. § 102, each and every element of each claim in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully traverses the rejection, as the cited reference does not teach each and every element of independent claim 1.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites a manufacturing method including:

depositing a dielectric film on an inner face of the formed hole [and] heat-treating the deposited dielectric film . .
embedding a resist film into the hole except an upper portion of the inner face of the hole on which the dielectric film and the silicon film are deposited etching the silicon film on the heat-treated dielectric film with the embedded resist film as a mask . . . [and] etching the silicon film on the heat-treated dielectric film with the embedded resist film as a mask

(emphasis added).

At page 3 of the Office Action, the Examiner appears to contend that Morie discloses “embedding a resist film (21) in the hole except an upper portion of the inner face of the hole . . . [and] etching the silicon film on the heat-treated dielectric film with the embedded resist film as a mask.” This is incorrect.

Morie discloses in Fig. 3F (as described in column 5, lines 1-20) that “substrate 11 is etched by a known etching technique using the mask layer 21 as a mask.” In addition, Morie teaches forming a “silicon oxide layer 21 by a known thermal oxidation [method].” Col. 4, lines 64-66.

However, to the extent that the forming of silicon oxide layer 21 disclosed by Morie corresponds to “depositing a dielectric film,” the reference is silent regarding “heat-treating the deposited dielectric film,” as recited in claim 1, and thus cannot teach or suggest “etching the silicon film on the heat-treated dielectric film with the embedded resist film as a mask.” Accordingly, claim 1 is not anticipated by Morie for at least this reason.

Claim 9 recites similar limitations to those recited in claim 1 and is allowable over Morie for at least the same reason as claim 1. Claims 2 and 8 depend from independent claim 1, and claims 10 and 16 depend from independent claim 9, and thus

each of these dependent claims are allowable over Morie at least due to their dependence. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 2, 8-10, and 16 as being anticipated by Morie.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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